



**UNITED STATES DEPARTMENT OF COMMERCE**

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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EXAMINER
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ART UNIT	PAPER NUMBER
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DATE MAILED:

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

# Advisory Action

Application No

09/068,528

Applicant(s)

Koizumi et al.

Examiner

Manjunath N. Rao

Art Unit

1652



-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

THE REPLY FILED 6/8/01 and 7-9-01 FAILS TO PLACE THIS APPLICATION IN CONDITION FOR ALLOWANCE. Therefore, further action by the applicant is required to avoid the abandonment of this application. A proper reply to a final rejection under 37 CFR 1.113 may only be either: (1) a timely filed amendment which places the application in condition for allowance; (2) a timely filed Notice of Appeal (with appeal fee); or (3) a timely filed Request for Continued Examination (RCE) in compliance with 37 CFR 1.114.

## THE PERIOD FOR REPLY [check only a) or b)]

- a) ☒ The period for reply expires 4 months from the mailing date of the final rejection.
- b) ☐ In view of the early submission of the proposed reply (within two months as set forth in MPEP § 706.07 (f)), the period for reply expires on the mailing date of this Advisory Action, OR continues to run from the mailing date of the final rejection, whichever is later. In no event, however, will the statutory period for the reply expire later than SIX MONTHS from the mailing date of the final rejection.

Extensions of time may be obtained under 37 CFR 1.136(a). The date on which the petition under 37 CFR 1.136(a) and the appropriate extension fee have been filed is the date for purposes of determining the period of extension and the corresponding amount of the fee. The appropriate extension fee under 37 CFR 1.17(a) is calculated from: (1) the expiration date of the shortened statutory period for reply originally set in the final Office action; or (2) as set forth in (b) above, if checked. Any reply received by the Office later than three months after the mailing date of the final rejection, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

1. A Notice of Appeal was filed on \_\_\_\_\_. Appellant's Brief must be filed within the period set forth in 37 CFR 1.192(a), or any extension thereof (37 CFR 1.191(d)), to avoid dismissal of the appeal.
2. ☒ The proposed amendment(s) will be entered upon the timely submission of a Notice of Appeal and Appeal Brief with requisite fees.
3. ☐ The proposed amendment(s) will not be entered because:
- (a) ☐ they raise new issues that would require further consideration and/or search. (See NOTE below);
  - (b) ☐ they raise the issue of new matter. (See NOTE below);
  - (c) ☐ they are not deemed to place the application in better form for appeal by materially reducing or simplifying the issues for appeal; and/or
  - (d) ☐ they present additional claims without cancelling a corresponding number of finally rejected claims.

NOTE: \_\_\_\_\_

4. Applicant's reply has overcome the following rejection(s): \_\_\_\_\_
5. ☐ Newly proposed or amended claim(s) \_\_\_\_\_ would be allowable if submitted in separate, timely filed amendment cancelling the non-allowable claim(s).
6. ☒ The a) ☐ affidavit, b) ☐ exhibit, or c) ☒ request for reconsideration has been considered but does NOT place the application in condition for allowance because:  
See attached
7. ☐ The affidavit or exhibit will NOT be considered because it is not directed SOLELY to issues which were newly raised by the Examiner in the final rejection.
8. ☒ For purposes of Appeal, the status of the claim(s) is as follows (see attached written explanation, if any):  
Claim(s) allowed: \_\_\_\_\_  
Claim(s) objected to: \_\_\_\_\_  
Claim(s) rejected: 1, 5, 8, and 15-20
9. The proposed drawing correction filed on \_\_\_\_\_ a) ☐ has b) ☐ has not been approved by the Examiner.
10. ☐ Note the attached Information Disclosure Statement(s) (PTO-1449) Paper No(s): \_\_\_\_\_
11. ☐ Other: \_\_\_\_\_

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***Advisory Action***

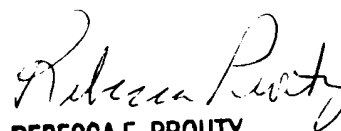
1. The amendments and the request to reconsider filed on June 18, 2001, paper No. 21 and the supplemental amendment filed on 7-9-01, paper No. 23 has been considered but does NOT place the application in condition for allowance because of the following.

While cancellation of claim 17 has overcome the rejection of that claim, the arguments and amendments presented is not persuasive to overcome the rejection of claims 1, 5, 8 and 15-20 under 35 U.S.C. 103(a) as being obvious over Maruyama et al. in view of Weissborn et al. Applicants argue that they have amended claim 1 to recite specific sugar selected from the group consisting of glucose, fructose, galactose, N-acetylglucosamine, N-acetylgalactosamine, mannose, N-acetylmannosamine and N-acetylneuraminic acid or a treated product of the culture broth, as a result of which the Weissborn et al. reference does not apply. Applicants argue that Weissborn et al. simply discloses that UDP-glucose is detected in a reaction solution using a cell extract containing the galU gene product of *E.coli* from UTP and glucose-1-phosphate. Applicants also argue that Weissborn et al. neither discloses nor suggest that the sugar nucleotide can be produced using as substrate applicants' sugar instead of glucose phosphate and therefore, even if Weissborn's method of confirming the activity of galU gene product is combined with Maruyama's method of producing UTP, there is simply no *prima facie* case of obviousness. Examiner respectfully disagrees. This is because applicants, while amending the sugar substrates have also included "treated product of culture broth" regarding which Examiner takes the position that such "treated products" would include glucose-1-phosphate and therefore the claims are not limited just to the sugar substrates indicated in claim 1. Therefore, Weissborn et al. and Maruyama et al. renders the claims *prima facie* obvious. Hence the above rejection is maintained.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Manjunath Rao whose telephone number is (703) 306-5681. The Examiner can normally be reached on M-F from 6:30 a.m. to 3:00 p.m. If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's supervisor, P.Achutamurthy, can be reached on (703) 308-3804. The fax number for Official Papers to Technology Center 1600 is (703) 305-3014. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-0196.

Manjunath N. Rao. Ph.D.  
July 25, 2001

  
**REBECCA E. PROUTY**  
**PRIMARY EXAMINER**  
**GROUP 1800**  
(602)